

### **REMARKS**

Applicants have amended claim 6 to more appropriately define the present invention. Claims 1-11 remain pending and under current examination.

In the Office Action, the Examiner rejected claim 6 under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the enablement requirement; rejected claims 1-11 under 35 U.S.C. § 101 because they allegedly do not provide a useful, concrete, and tangible result; rejected claims 1, 3, 9, and 11 under 35 U.S.C. § 103(a) as being unpatentable over Mankoff et al. (U.S. Patent No. 6, 385,591 B1) ("Mankoff") in view of DeLuca et al. (U.S. Patent No. 5,870,030) ("DeLuca"); rejected claims 2 and 10 under 35 U.S.C. § 103(a) as being unpatentable over Mankoff in view of DeLuca and Golden et al. (U.S. Patent No. 5,761,648) ("Golden"); rejected claims 4-6 under 35 U.S.C. § 103(a) as being unpatentable over Mankoff in view of the English language "equivalent"<sup>1</sup> of Sim (KR2000030358A) ("Sim"); and rejected claims 7 and 8 under 35 U.S.C. § 103(a) as being unpatentable over Mankoff in view of Sim and DeLuca. Applicants traverse the rejections for the following reasons.<sup>2</sup>

#### **Rejection of Claim 6 under 35 U.S.C. § 112, first paragraph**

Applicants traverse the rejection of claim 6 under 35 U.S.C. § 112, first paragraph, "as failing to comply with the enablement requirement" (Office Action, p. 2). Nevertheless, Applicants have amended claim 6 to more appropriately define the claimed invention, by more clearly reciting the printing of the coupon transmitted to the computer associated with the inputted information. This amendment to claim 6 overcomes the 35 U.S.C. § 112, first paragraph rejection. Applicants accordingly request withdrawal of this rejection.

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<sup>1</sup> Office Action, p 4.

<sup>2</sup> The Office Action contains statements characterizing the related art, case law, and the claims. Regardless of whether any such statements are specifically identified herein, Applicants decline to automatically subscribe to any statements in the Office Action.

**Rejection of Claims 1-11 under 35 U.S.C. § 101**

Applicants respectfully traverse the rejection of claims 1-11 under 35 U.S.C. § 101 for allegedly not providing “a useful, concrete and tangible result” (Office Action, p. 2). The Examiner alleged that

[t]he claim concludes with showing the coupon to a retailer. The “to redeem” language is not taken to be positively set forth and is merely taken to provide preparatory steps in order that the redemption may occur. Applicant should include the positive step of retailer redemption in order to accomplish the required useful, concrete and tangible result (Office Action, pp. 2-3).

The Examiner’s assertion that “[t]he “to redeem” language is not taken to be positively set forth and is merely taken to provide preparatory steps in order that the redemption may occur” is not a proper indication that the claims are non-statutory. In fact, a process may be statutory even where

some or all the steps therein can also be carried out in or with the aid of the human mind or because it may be necessary for one performing the processes to think. All that is necessary, in our view, to make a sequence of operational steps a statutory “process” within 35 U.S.C. 101 is that it be in the technological arts so as to be in consonance with the Constitutional purpose to promote the progress of “useful arts.” Const. Art. 1, sec. 8. *In re Musgrave*, 167 USPQ 280, 289-290 (CCPA 1970).

Furthermore, according to the Federal Circuit, if a claim includes recitations that produce “a concrete, tangible and useful result,” the claim is not abstract and has practical utility. *See State St. Bank & Trust Co. v. Signature Fin. Group, Inc.*, 149 F.3d 1368, 1373 (Fed. Cir. 1998). *See also AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, 1358 (Fed. Cir. 1999). Thus, if the claim is not abstract and has practical utility, it is statutory under 35 U.S.C. § 101. (*Id.*) *See also*, M.P.E.P. § 2106(IV)(B)(2)(b) (“A claim is limited to a practical application when the method, as claimed, produces a concrete, tangible and useful result; i.e., the method recites a step or act of producing something that is concrete, tangible and useful.”). Consequently, if

claims 1-11 produce a useful, concrete, and tangible result, then this alone establishes claims 1-11 as being drawn to statutory subject matter.

Under the proper standard, it is clear that independent claims 1-11 produce a useful, concrete, and tangible result, and are therefore drawn to statutory subject matter. For example, “displaying the coupon on the second computer; and showing the displayed coupon to a retailer...” (claim 1) is a useful, non-abstract result that facilitates a method for providing purchasing incentives to customers. Similar elements are recited in independent claims 4 and 9.

For at least these reasons, claims 1-11 are statutory under 35 U.S.C. § 101. Accordingly, Applicants request that the rejection of claims 1-11 under 35 U.S.C. § 101 be withdrawn.

**Rejection of Claims 1, 3, 9, and 11 under 35 U.S.C. § 103(a)**

Applicants traverse the rejection of claims 1, 3, 9, and 11 under 35 U.S.C. § 103(a) as being unpatentable over Mankoff in view of DeLuca. Applicants respectfully disagree with the Examiner’s arguments and conclusions. A *prima facie* case of obviousness has not been established.

“To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant’s disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).” M.P.E.P. § 2142, 8th Ed., Rev. 2 (May 2004), p. 2100-128.

In particular, the Examiner has not shown any suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify Mankoff with DeLuca to produce the claimed invention.

The M.P.E.P. states:

Obviousness can only be established by combining or modifying the teaching of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art.” “[I]t is necessary to ascertain whether or not the reference teaching would appear to be sufficient for one of ordinary skill in the relevant art having the reference before him to make the proposed substitution, combination, or other modification. M.P.E.P. § 2143.01, emphasis added.

One skilled in the art could have arrived at the present claimed invention only by consulting Applicants’ disclosure, yet “[t]he teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant’s disclosure.” M.P.E.P. § 2142, internal citations omitted. Applicants submit that Mankoff and DeLuca do not provide the requisite motivation to one of ordinary skill in the art to facilitate their combination, from within the references themselves. Applicants also note that one of ordinary skill in the art must have this motivation or reason *without the benefit of Applicants’ specification* to modify the references.

Mankoff and DeLuca fail to provide the requisite motivation to facilitate their combination for the following reasons. Mankoff focuses on downloading a virtual coupon to a PDA and automatically saving the download in a coupon file. “When the user desires to redeem a coupon, he or she may take the PDA to a terminal located in a retail establishment. By synchronizing the PDA to the terminal, the virtual coupon is redeemed...” (Abstract). DeLuca, on the other hand, discusses pictorial representation of a bar code on a pager device for scanning across a laser scanner typically used at supermarkets. “Alternatively, instead of a coupon-style bar code written on the display, a multicharacter alphanumeric code is written on the display [of the pager] for visual observation and manual recordation by a sales clerk” (col. 10, line 66 to col. 11, line 2). Downloading and synchronization of PDA coupon data for uploading and redeeming a virtual coupon at a terminal in a retail establishment (Mankoff) does not lend itself to

combination (or modification with) a pictorial representation (bar code or alphanumeric) of coupon data on a pager or other device for visual inspection by a sales clerk (DeLuca).

Applicants therefore submit that one of ordinary skill in the art would not have been motivated to combine Mankoff's system of PDA storage of coupon data for uploading and redemption on a terminal at a retail establishment with DeLuca's system of visual observation and manual recordation by a sales clerk of coupon data displayed on a pager.

Furthermore, Applicants dispute the Examiner's allegations that "[i]t would have been obvious to one with ordinary skill in the art [...] to have displayed the electronic coupons of Mankoff et al on the portable device in order to allow redemption by scanning or by simple inspection." (Office Action, pp. 3-4). Mankoff's system cannot be modified as suggested by the Examiner for at least the reason that DeLuca's system of visual observation and manual recordation by a sales clerk of coupon data displayed on a pager renders it unnecessary to have a special terminal at a retail establishment for synchronizing with a PDA to upload coupon data.

Applicants respectfully remind the Examiner that "[t]he initial burden is on the Examiner to provide some suggestion of the desirability of doing what the inventor has done." M.P.E.P. § 2142. The prior art references themselves must provide the motivation to combine, and the presently applied references clearly fail to do so, therefore failing to provide some suggestion of the desirability of doing what Applicants have done.

Finally, Applicants point out to the Examiner that it "is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art." *See In re Wesslau*, 147 U.S.P.Q. 391 (C.C.P.A. 1965). *See also* M.P.E.P. § 2141.02. The Examiner's combination of

Mankoff and DeLuca is not proper because the Examiner is selecting only so much of each reference to support his position while excluding other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art (e.g., the fact that DeLuca's visual observation and manual recordation by a sales clerk is not combinable with Mankoff's system of PDA storage of coupon data for uploading and redemption on a terminal at a retail establishment).

As already demonstrated, such combination of these references fails to establish obviousness of the claimed invention. Therefore, Applicants submit that Mankoff and DeLuca do not suggest the desirability of any modification which would result in Applicants' claimed invention.

Accordingly, the Examiner's reliance on Mankoff and DeLuca fails to establish *prima facie* obviousness. Claims 1 and 9 are allowable, and dependent claims 3 and 11 are also allowable at least by virtue of their respective dependence from allowable base claim 1 or 9. Therefore, the improper 35 U.S.C. § 103(a) rejection should be withdrawn.

**Rejection of Claims 2 and 10 under 35 U.S.C. § 103(a)**

Applicants traverse the rejection of dependent claims 2 and 10 under 35 U.S.C. § 103(a) as being unpatentable over Mankoff in view of DeLuca and Golden. Applicants respectfully disagree with the Examiner's arguments and conclusions. A *prima facie* case of obviousness has not been established.

This rejection addresses only dependent claims 2 and 10. The Examiner admitted that "Mankoff et al does not teach limiting the number of coupons to be downloaded to the user device" (Office Action, p. 4). The Examiner then applied Golden only to specifically teach "a feature whereby the user may download only a certain number of coupons" (Office Action, p. 4).

The Examiner's citation to Golden, however, does not address the fact that the combination of Mankoff and DeLuca is improper, and that there is no suggestion or motivation from within Mankoff and DeLuca to combine them.

The M.P.E.P. instructs, however, that dependent claims include everything recited in the base claim. *See* M.P.E.P. § 608.01(n)(III). As noted in the previous section, Applicants have already established that the Examiner has not shown any suggestion or motivation to combine Mankoff and DeLuca, from within the references themselves, and that their combination is improper. Thus, this 35 U.S.C. § 103(a) rejection of dependent claims 2 and 10 must also fail.

The Examiner has therefore not met the essential criteria for establishing a *prima facie* case of obviousness. Thus, dependent claims 2 and 10 are allowable for the reasons presented herein, and at least by virtue of their respective dependence from allowable base claim 1 or 9. Therefore, the improper 35 U.S.C. § 103(a) rejection of claims 2 and 10 should be withdrawn.

**Rejection of Claims 4-6 under 35 U.S.C. § 103(a)**

Applicants traverse the rejection of claims 4-6 under 35 U.S.C. § 103(a) as being unpatentable over Mankoff in view of Sim. Applicants respectfully disagree with the Examiner's arguments and conclusions. A *prima facie* case of obviousness has not been established.

Applicants first submit that this rejection is improper on its face, because it does not even address the elements of Applicants' independent claim 4. The Examiner admitted that "Mankoff et al does not teach delivery to wireless phones" (Office Action, p. 4), and applies Sim to teach "delivery of electronic coupons to wireless phone users" (Id.). Even with the Examiner's admitted deficiency in Mankoff, nothing cited by the Examiner in either Mankoff or Sim addresses the elements of independent claim 4, other than to say that Mankoff's "coupon is taken

to be a purchasing incentive” (Office Action, p. 5). That is, the Examiner has not provided any evidence in the text of the rejection or by citation to Mankoff or Sim that would show that either or both reference teach or suggest at least:

A method for providing purchasing incentives to customers, comprising: transmitting an advertisement from a first computer to a second computer, said advertisement offering a purchasing incentive to a customer; inputting information into the second computer, wherein the inputted information directs a third computer to transmit a coupon associated with the advertisement to a computer associated with the inputted information; transmitting the inputted information to the third computer; and transmitting the coupon to the computer associated with the inputted information (claim 4).

Should the Examiner maintain the 35 U.S.C. § 103(a) rejection after considering the arguments presented herein, Applicant respectfully submits that the Examiner must provide evidence from within the cited references themselves that addresses each and every element of Applicants’ independent claim 4, or else withdraw the rejection.

The Examiner’s reliance on Mankoff and Sim fails to establish *prima facie* obviousness. Claim 4 is allowable, and dependent claims 5 and 6 are also allowable at least by virtue of their dependence from allowable base claim 4. Therefore, the improper 35 U.S.C. § 103(a) rejection should be withdrawn.

**Rejection of Claims 7 and 8 under 35 U.S.C. § 103(a)**

Applicants traverse the rejection of claims 7 and 8 under 35 U.S.C. § 103(a) as being unpatentable over Mankoff in view of Sim and DeLuca. Applicants respectfully disagree with the Examiner’s arguments and conclusions. A *prima facie* case of obviousness has not been established.

This rejection addresses only dependent claims 7 and 8. The Examiner admitted that “[i]t is not clear to what extent Mankoff et al’s coupon to be redeemed is displayed to a retailer, however the examiner is relying on DeLuca et al for such display (to then redeem)” (Office



Action, p. 6). The Examiner then cited DeLuca to teach “that the portable coupon device may display a text or barcode coupon in order for a retailer clerk to visually redeem the coupon” (Id.). The Examiner’s additional citation to Sim, however, does not address the fact that the combination of Mankoff and DeLuca is improper, and that there is no suggestion or motivation from within Mankoff and DeLuca to combine them. Applicants have already established this in the arguments presented above against the rejection of independent claim 1, from which claims 7 and 8 depend.

The M.P.E.P. instructs, however, that dependent claims include everything recited in the base claim. *See* M.P.E.P. § 608.01(n)(III). As noted in previously, Applicants have already established that the Examiner has not shown any suggestion or motivation to combine Mankoff and DeLuca, from within the references themselves, and that their combination is improper. The addition of Sim “in order to allow redemption by scanning or by simple inspection” (Office Action, p. 6) does nothing to show there would be any suggestion or motivation to combine Mankoff and DeLuca, from within the references themselves. Thus, this 35 U.S.C. § 103(a) rejection of dependent claims 7 and 8 must also fail.

The Examiner has therefore not met the essential criteria for establishing a *prima facie* case of obviousness. Thus, dependent claims 7 and 8 are allowable for the reasons presented herein, and at least by virtue of their dependence from allowable base claim 1. Therefore, the improper 35 U.S.C. § 103(a) rejection of claims 7 and 8 should be withdrawn.

### **Conclusion**

In view of the foregoing, Applicants request reconsideration of the application and withdrawal of the objection and rejections. Pending claims 1-11 are in condition for allowance, and Applicants requests a favorable action.

Applicants encourage the Examiner to contact the undersigned representative by telephone to discuss any remaining issues or to resolve any misunderstandings.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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